REMARKS

Double Patenting Rejections

1. Rejection under the judicially created doctrine of obviousness –type double patenting over claims 1-35 of United States Patent No. 6,132,740 and the Provisional judicially created doctrine of obviousness –type double patenting over copending U.S. patent application Ser. No. 10/020,037.

Applicant files herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) disclaiming the terminal portion of the statutory term of claims 1-17 issuing from the US patent application Ser. No. 10/060,040 to make it coextensive with U.S Patent No. 6,132,740 and allowed claims 1-41 of copending U.S. patent application Ser. No. 10/020,037. Applicant respectfully suggests that the Double Patent Rejections are rendered moot and should be withdrawn.

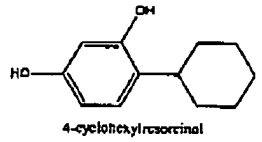
Rejections under 35 USC §102

3. Rejection under 35 U.S.C. 102(e) as anticipated by United States Patent No. 6,132,740.

Applicant respectfully traverses the rejection of claims 1-17 under 35 U.S.C. 102(e) over United States Patent No. 6,132,740 ("the '740 patent").

Applicant acknowledges that the '740 patent discloses a genus that encompasses the compound of the present invention. However, the specific compound, 4-(2,4-dihydroxyphenyl)cyclohexanol claimed in the present application is not specifically disclosed. Applicant respectfully points out that the compound noted by the Examiner at

'example I, in the claims and at col. 3, lines 43-44' (Official Action mailed May 13, 2004, at page 4-5) has the following structure



and is not identical to that claimed in claims 1-17 of the present application.

The compound claimed in the present application has a hydroxyl substituent on the cyclohexyl ring. While the '740 application discloses a genus that encompasses the compound of the present invention, it does not specifically exemplify, name or claim the specific compound claimed in the instant application, 4-(2,4-dihydroxyphenyl)cyclohexanol. The disclosure of a genus in the '740 patent that encompasses the species of the present invention does not render the species anticipated. The courts have held that a prior genus which does not explicitly disclose a species does not anticipate a later claim to that species. (Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 1262, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989)).

35 U.S.C. 102(e) requires that each and every element of a claim be disclosed in the cited reference in order for it to anticipate a claim of the present application. Claims 1-17 require 4-(2,4-dihydroxyphenyl)cyclohexanol as an element of each claim. As noted above, this element of claims 1-17 is not specifically disclosed in the '740 patent either as an exemplified chemical entity or for use in a topical composition for treating skin lightening or reducing skin pigmentation. Applicant respectfully requests that in the absence of a specific disclosure of the 4-(2,4-dihydroxyphenyl)cyclohexanol of the present invention in the '740 patent, the rejection of claims 1-17 as anticipated by the '740 patent be reconsidered and withdrawn.

For the same reasons provided above, applicant traverses the rejection of claims 1-17 under 35 U.S.C. 102(f) alleging that the applicant did not invent the claimed subject matter in light of United States Patent No. 6,132,740. As noted above, the 4-(2,4-dihydroxyphenyl)cyclohexanol compound of the present invention was not specifically disclosed in the '740 patent. Uses of the 4-(2,4-dihydroxyphenyl)cyclohexanol compound

for treating skin lightening or reducing skin pigmentation were also not specifically disclosed in the '740 patent. Therefore, the examiner has provided no evidence that the applicant did not invent the subject matter of the present application. Applicant respectfully request that the rejection of claims 1-17 under 35 U.S.C. 102(f) be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103(a)

4. Rejection of claims 1-17 under 35 U.S.C. 103(a) as obvious in light of United States Patent No. 6,132,740 and United States Serial No.10/020,037.

Applicant wish to make of record that at the time the inventions disclosed and claimed in the present application, US Serial No. 10/061,040, US Serial No.10/020,037, and United States Patent No. 6,132,740 were made, all of the inventors were under an obligation to assign all rights in their inventions to OSI Pharmaceuticals, Inc. (OSI). OSI has assigned all of its US rights in the inventions disclosed and claimed in the above-identified patent and patent applications to Pfizer, Inc. Each of the assignment documents have been recorded in the United States Patent and Trademark Office and are of record in the corresponding files for the patent and patent applications. However, copies of each of these assignment documents will be provided to the Examiner upon request.

Applicant, therefore, request that the rejection of claims 1-17 as obvious under 35 U.S.C. 103(a) in light of both US Serial No.10/020,037 and United States Patent No. 6,132,740 be reconsidered and withdrawn in light of the common ownership of the inventions at the time this invention was made and the continued common ownership of the patent and patent applications.

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 734-622-4182.

Respectfully submitted,

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